

Application No.: 10/658,877
Response dated June 8, 2005
Reply to Office Action of March 21, 2005
Docket No.: 500-148 PCT/US/CON 2
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Remarks/Arguments:

Introduction

Claims 1-16 are pending.

Section 103 Rejections

Claims 1-16 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Patent No. 3,893,496 to Wallace et al. (hereinafter "Wallace") and U.S. Patent No. 4,705,722 to Ueda et al (hereinafter "Ueda") and further in view of U.S. Patent No. 5,172,841 to Friedman (hereinafter "Friedman"). Applicants respectfully traverse.

The Action alleges that:

Wallace discloses a method for sealing a threaded joint assembly comprising a joint sealing material (FIGS. 1 and 2).

Wallace does not disclose the sealing material comprising a multifilament yarn and a joint sealing composition readily coated over the yarn.

Wallace also does not disclose the joint sealing material packaged in a dispenser.

Ueda does disclose a sealing material comprising a multifilament yarn and a joint sealing composition readily coated over the yarn in order to achieve improved sealing versatility (col. 1, line 66).

Friedman discloses material packed in a dispenser in order to provide a means for holding a yarn (mass [sic], col. 1, line 47).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the joint sealing assembly of Wallace as taught by Ueda. (Office Action dated March 21, 2005, page 2) (emphasis added)

Except for the above-noted deficiencies of Wallace as admitted by the Examiner, Applicants respectfully traverse.

Wallace is directed to a liquid composition to be applied on threads of a threaded part, as follows:

The present invention relates to a threaded part, either male or female, in which the threads of a portion thereof are treated with a resinous material applied in substantially liquid form.... (Wallace, column 1, lines 11-14) (emphasis added)

Wallace teaches that its compositions must be applied in liquid form to the threaded parts by spraying or dipping, as follows:

The resinous mixture disclosed herein may be applied to the threads in a variety of ways, such for example ... [by having them] passed across a horizontally directed stream of fluid polymer ... [or] dipped into the fluid resinous composition, after which the excess material may be permitted to drain off the end. (Wallace, column 1, lines 63, to column 2, line 15) (emphasis added)

After the liquid composition is applied to threaded parts, Wallace teaches that the composition is dried to form a coating on the threaded parts, as follows:

[A]fter the application of the resinous material in fluid condition, a solvent which determines the fluidity of the resinous material is evaporated. (Wallace, column 2, lines 16-18) (emphasis added)

Moreover, Wallace states that the intended purpose for its compositions are to provide and maintain frictional resistance to prevent rotational movement of adjacent surfaces, such as threaded parts, as follows:

[T]he purpose of [the present invention is for] establishing and maintaining a frictional resistance to relative motion between adjacent surfaces. [In particular, for] establishing a frictional resistance to relative rotation between threaded members..... (Wallace, column 2, lines 54-60) (emphasis added)

Thus, Wallace teaches a method for sealing threaded parts which includes the steps of applying its composition to the threaded part as a liquid and then subsequently drying the liquid to form a coating on the threaded part. Wallace further teaches its methods are to be specifically used for preventing rotational movement between adjacent surfaces.

Ueda is directed the use of flexible graphite gland packing for sealing machinery shafts, as follows:

This invention relates to a gland packing made of flexible graphite for use in a shaft seal part of the like portion of a hydraulic machine. (Ueda, column 1, lines 6-8) (emphasis added)

It is well-known in the art that gland packings are used for sealing rotating parts and are not used for preventing movement of adjacent parts.¹ Thus, the gland packing of Ueda operates in an entirely different manner and is used for an entirely different purpose than the methods and compositions of Wallace.

Further, the gland packing of Ueda is formed from flexible graphite. Ueda describes that flexible graphite cannot be directly used as gland packing because it is too brittle, but when flexible graphite sheets are covered up with a fiber the resultant article could be twisted, for example wound about a shaft, without breakage. (Ueda, column 1, lines 35-65.) Moreover, Ueda describes that the fiber is preferably to be removed to improve sealing and to reduce frictional resistance of the gland packing against the moving shaft. (Ueda, column 3, lines 25-

¹ See, e.g., THE NEW SHORTER OXFORD ENGLISH DICTIONARY 1096 (Thumb Index ed. 1993) ("gland *n.* A sleeve which fits around a piston rod or other shaft to form a seal, esp. by compressing a packing around the rod."); Theodore Baumeister et al., MARKS STANDARD HANDBOOK FOR MECHANICAL ENGINEERS 8-143-47 (8th ed. 1978) ((stating that dynamic packing, such as packing glands, "operate on moving surfaces [including] ... rotary shafts...").

33.) Further, it is well-known in the art that graphite is a lubricant.² Such a lubricant is in direct contrast to the compositions and methods of Wallace. Thus, Ueda utilizes a fiber so that its graphite may be simply twisted around a shaft to provide sealing thereat while also permitting movement of the shaft by imparting lubricity.

Still further, Ueda fails to teach or suggest that its fiber may be coated with a composition, for example a joint-sealing composition. The fiber of Ueda covers the flexible graphite. Ueda fails to teach or suggest that the flexible graphite or other compositions may be coated onto the fiber. Indeed, Ueda teaches away from the use of coated fibers. For example, Ueda teaches that the graphite surface may be treated with a sealer, but such treatment is only applied after the fiber is removed, as follows:

[T]he Aramid fiber (an aromatic polyamide fiber) 2 exposed on the surface of the cord-like structure is burned off by means of a burner, the surface being then impregnated with a sealer 5 comprising silicone oil, scale-form graphite, rubber-based adhesive or the like. (Ueda, column 2, lines 55-60) (emphasis added)

Thus, Ueda not only fails to teach or suggest the use of a coated fiber, but teaches away from the use of a coated fiber by requiring that the fiber be burned away prior to any application of a sealing composition.

Friedman is directed to a cord dispensing apparatus specifically intended to be used for binding piles of newspapers. (Friedman, column 1, lines 6-12 and 37-39.) Friedman fails to teach or suggest that its cord may be coated with a material, such as a joint-sealing composition. Friedman also fails to teach or suggest that its apparatus may be used for a joint sealing material. Further, the apparatus of Friedman has a hole 42 through which the cord 116 egresses from the apparatus 10. Such an apparatus is in direct contrast to the container of

² See, e.g., WEBSTER'S NEW WORLD DICTIONARY 588 (3rd College ed. 1994) ("graphite *n.* a soft, black, lustrous form of carbon found in nature and used for ... lubricants...."); Theodore Baumeister et al., MARKS STANDARD HANDBOOK FOR MECHANICAL ENGINEERS 3-25 (8th ed. 1978) ([S]olid lubricants [include] ... graphite....").

Wallace which requires that its compositions be bottled, presumably to prevent evaporation of its required solvent from its compositions.

In contrast, the invention as presently defined by independent claim 1 is directed to a method for sealing a threaded assembly. The inventive method comprises providing a dispenser having a joint-sealing material packaged therein, where the joint-sealing material comprises a multifilament yarn and a joint-sealing composition ready coated over the yarn; removing a portion of the joint-sealing material from the dispenser; and applying the portion of the joint-sealing material to threads of a first threaded component of the threaded assembly.

Wallace, Ueda and Friedman, individually or in combination fail to teach or suggest the present invention because these references fail to disclose, teach or suggest, *inter alia*, a joint-sealing material comprising a multifilament yarn and a joint-sealing composition ready coated over the yarn.

Wallace specifically teaches that its thread sealing compositions are to be applied in, liquid form to, after curing, prevent rotational movement of adjacent parts. Wallace thus also fails to disclose, teach or suggest that its compositions may be readily coated over a multifilament yarn.

Ueda fails to disclose, teach or suggest that its Aramid fibers, i.e., yarns, may be coated with a composition. Indeed, Ueda teaches away from coating yarns by specifically requiring that the yarns be burned off prior to any application of a sealant to its graphite. Thus, Ueda teaches away from the present invention and further teaches away from coating its fibers with compositions, for example the compositions of Wallace. Even assuming *arguendo* that the Examiner may consider the graphite members of Ueda as being yarns, Ueda still teaches away from the present invention. As described above, graphite is a well-known lubricant useful for aiding in movement of adjacent parts. This is in direct contrast to the composition

requirements of Wallace which are specifically formulated to prevent or prohibit rotational movement of adjacent parts.

Friedman fails to cure the deficiencies of Wallace and Ueda. Friedman is merely directed to a cord dispenser useful for binding piles on newspapers and fails to teach or suggest, *inter alia*, any compositions being ready coated over its cord. Further, Friedman teaches away from Wallace by requiring an open hole in its dispenser while Wallace requires that when its compositions are to be stored that they must be bottled.

In establishing a *prima facie* case of obviousness, each of the cited references must be considered for the entirety of their respective teachings. *Bausch & Lomb, Inc. v. Barnes-Hind, Inc.*, 230 U.S.P.Q. 416, 419 (Fed. Cir. 1986). Further, it is impermissible during examination to pick and choose from a reference only so much that supports the alleged rejection. *Id.* Thus, the express teachings of Wallace, Ueda and Friedman, which would lead one away from the methods of the present invention, may not be ignored during examination.

Further, it is incumbent upon the Examiner to provide a reason why one of ordinary skill in the art would have been led to modify a cited document or to combine documents to arrive at the claimed invention. The requisite motivation for relying upon the cited documents and making the proposed combination must refer to some disclosure, teaching or suggestion in or inference from the cited documents as a whole, or from the knowledge generally available to one of ordinary skill in the art and not from Applicants' own disclosure. *In re Oetiker*, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992).

Moreover, it is well established that hindsight reconstruction of a reference does not present a *prima facie* case of obviousness and any attempt at hindsight reconstruction using Applicants' disclosure is strictly prohibited. *In re Oetiker*, 24 U.S.P.Q.2d at 1445-46.

With Wallace and Ueda having divergent and contrary teachings, intended uses, purposes and functions, one of ordinary skill in the art would not be motivated to combine the

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teachings, and the Examiner has provided no reason why those of ordinary skill in the art would be motivated or suggested from the cited documents to support the attempted combination. The only teaching of a joint-sealing material comprising a multifilament yarn and a joint-sealing composition ready coated over the yarn is the subject application. Any attempt at hindsight reconstruction using the subject teachings is strictly prohibited.

Thus, it is respectfully submitted that claim 1 and all claims dependent therefrom are patentably distinct over Wallace, Ueda and Friedman, individually or in combination. Therefore withdrawal and reconsideration of the rejection of claims 1-16 are respectfully requested.

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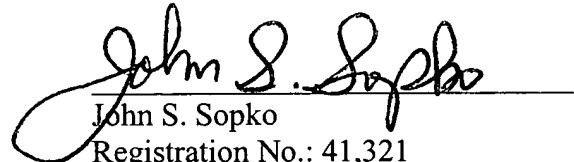
Summary

Therefore, Applicants respectfully submit that claims 1-16 are patentably distinct over the cited documents of record. This application is believed to be in condition for allowance. Favorable action thereon is therefore respectfully solicited.

Should the Examiner have any questions or comments concerning the above, the Examiner is respectfully invited to contact the undersigned attorney at the telephone number given below.

The Commissioner is hereby authorized to charge payment of any additional fees associated with this communication, or credit any overpayment, to Deposit Account No. 08-2461. Such authorization includes authorization to charge fees for extensions of time, if any, under 37 C.F.R. § 1.17 and also should be treated as a constructive petition for an extension of time in this reply or any future reply pursuant to 37 C.F.R. § 1.136.

Respectfully submitted,


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